

### **REMARKS/ARGUMENTS**

The Office Action mailed on January 12, 2005 has been carefully considered. Claims 12-33 are previously pending, with Claims 12, 19, 26 and 30 being the independent claims. Claims 12-24, 26-27 and 30-31 stand rejected. Claims 25, 28-29 and 32-33 stand objected to.

In the forgoing Amendments, Applicants have amended Claims 19, 26 and 30, and canceled Claims 25, 29 and 30 without prejudice to or disclaimer of the subject matter therein. Support for these amendments can be found in the specification and claims of the application as filed. No new matter has been added by these amendments. Claims 12-24, 26-28, 30-31 and 33 remain pending in the application. Applicants respectfully request entry of the foregoing Amendments and reconsideration of the present application in light of the amendments above and the remarks below.

Applicants thank the Examiner for the indication of allowability of Claims 25, 28-29 and 32-33 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claim 19, 26 and 30 have been amended to explicitly incorporate all of the limitations of Claim 25, 29 and 32, respectively. Therefore, Claims 19, 26 and 30 are in the condition for allowance. Based at least on their dependence on independent Claims 19, 26 and 30, dependent Claims 20-24, 27-28, 31 and 33 are allowable as well. Applicants respectfully request the withdrawal of the rejection of these claims.

#### **The 35 U.S.C. § 102 Rejection**

Claims 12, 26 and 30 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Tsuchihashi et al. (US 4,955,654) (“Tsuchihashi”). Without admitting that Tsuchihashi is prior art and reserving the right to establish that it is not prior art, Applicants respectfully submit that this rejection is traversed for the reasons below.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup>

Applicants respectively submit that Tsuchihashi fails to disclose an apparatus having a capture mechanism and an actuator wherein the actuator is configured to apply force feedback to a peripheral device, which is engaged with the capture mechanism as claimed by the present invention. Specifically, Claim 12 of the present invention recites in part:

an actuator configured to apply force feedback to the peripheral device  
when the peripheral device is engaged by the capture mechanism

Emphasis added. In one aspect, an actuator is disposed within the apparatus (interface device) to provide force feedback to the peripheral device (an instrument). See abstract of the present invention. An advantage of the present invention is to enhance realism within a medical procedure simulation system by interfacing various peripherals via an interface device to enable realistic simulation of various aspects of a medical procedure. See summary of the application.

In contrast, Tsuchihashi discloses a “force sensor 607, which is structured with a strain gauge fitted to a support structure for the snare cable 206.” See col. 5, lines 18-20 of Tsuchihashi. Also, “when one of the snare cables 206 comes into contact with the grapple shaft 302 . . . the rise in speed of the rotary ring 205 is restricted by the feedback of the force sensor 607.” See col. 6, lines 46-50 of Tsuchihashi. The feedback disclosed by Tsuchihashi is used to control the driving system of the clamping portion 101. See col. 4, lines 61-63 of Tsuchihashi. Tsuchihashi essentially discloses a feedback of the force sensor 607, which may be an electrical signal, to control the snare cable 206, whereas the present invention discloses physical feedback

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<sup>1</sup> Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*,  
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force that allows a user to feel the force via a peripheral device. As can be seen, Tsuchihashi does not disclose or suggest such physical feedback force that can be applied to a peripheral device.

At least for this reason, Tsuchihashi can not anticipate Claim 12 under § 102.

Accordingly, Applicants respectfully submit that Claim 12 is patentable over Tsuchihashi. If an independent claim is valid, the claims that depend from the independent claim should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377, 1382 (Fed. Cir. 2000). Since Claims 13-18 depend from Claim 12, Claims 13-18 should also be patentable.

The Office Action further rejected Claims 26 and 30 as anticipated by Tsuchihashi under § 102. To expedite the allowance of present invention, Applicants have amended Claims 26 to incorporate the subject matter of Claim 29, which has been indicated as being allowable. As such, amended Claim 26 is now in the condition for allowance. Since Claims 27-28 depend from Claim 26, Claims 27-28 should also be in the condition for allowance.

Similarly, Claim 30 has been amended to incorporate the subject matter of Claim 32, which has been indicated as being allowable. Accordingly, the amended Claim 30 is now in condition for allowance. Since Claims 31 and 33 depend from Claim 30, Claims 31 and 33 should also be in condition for allowance.

### **The First 35 U.S.C. § 103 Rejection**

Claims 13, 14, 19, 27 and 31 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchihashi in view of Rosenberg et al. (US Pat. No. 5,805,140) (“Rosenberg”) among which claim 19 is an independent claim. Without admitting that

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814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Tsuchihashi and Rosenberg are prior art and reserving the right to establish that they are not prior art, Applicants respectfully submit that this rejection is traversed for the reasons below.

In order to expedite the allowance of Claim 19, Applicants have amended Claim 19 to explicitly incorporate all of the limitations of Claim 25, which has been indicated as being allowable. Accordingly, amended Claim 19 is now in condition for allowance. Since Claims 20-24 depend from Claim 19, Claims 20-24 should also be allowable.

### **The Second 35 U.S.C. § 103 Rejection**

Claims 15-18 and 20-24 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchihashi in view of Rosenberg in further view of Bailey (US Pat. No. 6,062,865). This rejection is overcome because, as discussed above, these claims depend from allowable claims.

### **Request for Entry of Amendment**

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

### **Conclusion**

Based on all of the above, Applicants believe all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

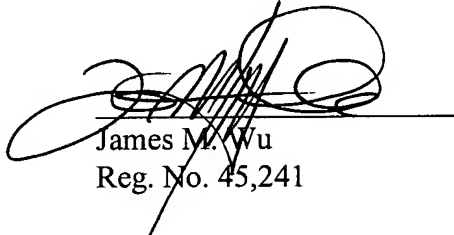
No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (408)282-1885.

Respectfully submitted,

THELEN REID & PRIEST, LLP

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James M. Wu  
Reg. No. 45,241

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 292-5800  
Fax. (408) 287-8040